THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte CONTEX, INC.

_____

Appeal No. 98-1446
Reexamination Control No. 90/004,325[1]

_____

Heard: August 4, 1998

_____

Before KRASS, FLEMING and LEE, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 16 of a re-examination of U.S. Patent No.

[1]Request filed August 5, 1996, for reexamination of U.S. Patent No. 4,952,045 granted August 28, 1990, based on Application 07/357,365 filed May 26, 1989.

4,952,045.

The invention relates to a corneal contact lens for use in the treatment of myopia. The lens contains three distinct zones, a center zone, a tear zone and a peripheral zone whereby each zone is characterized by a radius of curvature and lateral thickness. In particular, the center zone has a radius of curvature greater than the tear zone and the tear zone has a lateral thickness that is less than the center zone.

The independent claim 1 is reproduced as follows:

1. A corneal contact lens comprising:

> a central zone having a central zone radius of curvature and a central zone lateral thickness;
>
> a tear zone located concentrically around said central zone, said tear zone being integral with said central zone and having a tear zone radius of curvature and a tear zone lateral thickness wherein said tear zone radius of curvature is smaller than said central zone radius of curvature; and
>
> a peripheral zone located concentrically around said tear zone, said peripheral zone being integral with said tear zone and having a peripheral zone radius of curvature and a

> peripheral zone lateral thickness wherein said peripheral zone radius of curvature is greater than or equal to said central zone radius of curvature and wherein said central zone and said peripheral zone each have a lateral thickness which is greater than the lateral thickness of said tear zone.

The Examiner relies on the following references:

Graham 4,166,255 Aug. 28, 1979

Orthokeratology, vol. 2, issued 1974, Alfred A. Fontana, "Orthokeratology Using the One Piece Bifocal", pp. 22-24. (Fontana 74)

Orthokeratology, vol. 3, issued 1976, Alfred A. Fontana, "Orthokeratology", pp. 81-83. (Fontana 76)

Claims 1 through 10 and 16 stand rejected under 35 U.S.C. § 102 as being anticipated by Fontana 74 or Fontana 76. Claims 11 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fontana 74 and Graham or as being unpatentable over Fontana 76 and Graham.

OPINION

After careful review of the evidence before us, we agree with the Examiner that claims 1 through 10 and 16 are

anticipated under 35 U.S.C. § 102 by Fontana 76 and that claims 11 through 15 are unpatentable under 35 U.S.C. § 103 over Fontana 76 and Graham. However, we disagree with the Examiner in regard to the claims as anticipated by Fontana 1974.

At the outset, we note that Appellant argues in the briefs, the claims 1 through 10 and 16 as one group and claims 11 through 15 as another group. 37 CFR § 1.192 (c)(7) (July 1, 1996) ***as amended at*** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellants' filing the brief, states:

> For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider the Appellants' claims 1 through 10 and 16 as standing or falling together and we will treat claim

1 as a representative claim of that group and we will consider claims 11 through 15 as standing or falling together.

In regard to claims 1 through 10 and 16, it is axiomatic that anticipation of a claim under sec. 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." ***RCA Corp. v. Applied Digital Data Systems, Inc.,*** 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), *cert. dismissed,* 468 U.S. 1228 (1984), *citing* ***Kalman v. Kimberly-Clark Corp.,*** 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Appellant argues on page 6 of the brief the Fontana references do not disclose Appellant's limitations of a tear zone that provides for a reservoir of tear fluid for the proper positioning of the lens, and a tear zone that has a lateral thickness less than the central and peripheral zones.

Turning to Appellants' claim 1, we fail to find any limitation in the claim reciting a tear zone that provides for a reservoir of tear fluid for the proper positioning of the lens. We note that the claim recites "a tear zone … wherein said tear zone radius of curvature is smaller than said central zone radius of curvature." We note that in the second column of page 23 of Fontana 74, Fontana teaches a para central area which has a radius of curvature that is smaller than the central area. Appellant does not dispute that Fontana 74 teaches this limitation.

Furthermore, we note that Appellant's claim 1 recites that the central zone and the peripheral zone "each have a lateral thickness which is greater than the lateral thickness of said tear zone." Here lies what is in dispute as to whether Fontana 74 teaches the lateral thickness limitations recited in Appellant's claim 1.

Appellant, on page 7 of the brief, argues that Figure 1

shows that the para central area has a lateral thickness that is

greater than the center area. In particular, Appellant points out that Figure 1 of Fontana 74 shows the para central area as the darkest of the three zones described. Appellant argues that the degree of darkest of the lens is indicative of the degree of contact with the cornea. Furthermore, Appellant argues that for the paracentral area to be darker than both the central and peripheral zones, the paracentral zone must be laterally thicker than both adjacent zones. Accordingly, Appellant concludes the lens disclosed in Fontana 1974 does not disclose the Stoyan lens that has a tear zone with a lateral thickness less than the central and peripheral zones.

In contrast, the Examiner relies on the teaching found in the second column of page 23 of Fontana 74 and the Blackburn declaration submitted by the third party requester to support that Fontana teaches that para central area has thinner lateral thickness that the center and peripheral zones. The Examiner, points to the Blackburn's contention that Fontana 1974 discloses that the center zone would be ground first and then the paracentral and peripheral zones. Blackburn points

out the resulting lens has a structure wherein the central zone and the

peripheral zone each have a lateral thickness which is greater than the paracentral zone. Indeed, appellant agrees that *if* the center zone was ground first, the lens would result in a lateral thickness less in the paracentral zone than the other zones.

However, Appellant has submitted a declaration of Wlodyga in which Wlodyga declares that if the para central area was ground first and then the center zone then the resulting lens would have a lateral thickness greater than the center area. Wlodyga further points to Figure 1 and argues that Figure 1 supports that the para central area is darker than the center area and thereby has a greater lateral thickness than the center area.

In carefully reviewing both declarations, we fail to find any support for which order of grinding is used to make the Fontana 74 lens. We note that Fontana is silent to the order of grinding as well as the lateral thickness of the para

central area. Although we agree that the Fontana Figure 1 shows a darker ring, we fail to find any explanation of this Figure or under what condition and equipment the photograph is taken as well as the condition of the human eye. It is only speculation as to whether this ring is the para central area or the difference in contrast shows lateral thickness.

However, "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a ***prima facie*** case of unpatentability." ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Examiner has argued that the Fontana 74 lens inherently has a para central area having a lateral thickness which is less that the lateral thickness of the central area and peripheral area.

Claims rejected as being anticipated under 35 U.S.C. § 102 "must show that each element of the claim in issue is found, either expressly or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or

practice". ***Minnesota Min. and Mfg. v. Johnson & Johnson***, 976 F.2d 1559 (Fed. Cir. 1992), **citing *Kalman v. Kimberly-Clark Corp.,*** 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026, 104 S.Ct. 1284, 79 L.Ed.2d 687 (1984), *overruled in part on another ground,* ***SRI Int'l v. Matsushita Elec. Corp. of Am.,*** 775 F.2d 1107, 1125, 227 USPQ 577, 588-89 (Fed. Cir. 1985)(*in banc*).

We agree that it is at least speculative whether Fontana 74 teaches an order of grinding lens and therefore Fontana 74 does

not disclose the Stoyan lens. We do not wish to speculate as to

the significance of Fontana 74 Figure 1. However, we do at least agree that if the contrast shows that a portion is touching the cornea of the eye, that such a touching would not allow for the proper drainage of the eye. Therefore, we fail to find any evidence to indicate that Fontana 74 teaches one of ordinary skill in the art to begin to grind a lens in one

particular order or the lateral thickness of each of the areas of the lens.

We have not sustained the rejection of claim 1 through 10 and 16 under 35 U.S.C. § 102(b) as being anticipated by Fontana 74.

Turning to Fontana 76, we note that Fontana expressly teaches all of the limitations of Appellant's claim with the exception of the limitation directed to the lateral thickness of each zone. Appellant argues that Fontana 74 and Fontana 76 are a single reference. However, we note that Fontana 76 does not reference Fontana 74 in any way. Therefore, we must consider Fontana 76 on its face and determine as to what Fontana 76 would have taught to those skilled in the art. Finally, we note that neither the Blackburn declaration submitted by third party requester nor the Wlodyga declaration submitted by the Appellant addresses Fontana 76.

We agree that the three zones of claim 1 correspond to the areas of page 82 of Fontana 76 entitled "Orthofocus one piece

bifocal contact lens". Appellant's claim 1 has a limitation of a "central zone" which reads on the Fontana 76 "center circle" and the Appellant's claim 1 limitation of a "tear zone" reads on the Fontana 76 "Fit on 'K'" area. Lastly, the "peripheral zone" of Appellant's claim 1 reads on the "intermediate curve" and "peripheral curve" of Fontana 76.

Appellant's claim 1 further limits the tear zone by reciting that the radius of curvature is smaller than the central zone. However, we point out that Fontana 76 page 81, column 2, states the "flattest meridian of the keratometer readings is used as the base curve" which is equal to the curvature of the eye and corresponds to the "Fit on 'K'" area of page 82. The center circle design is 1 diopter ***flatter*** than the base curve. Thus, we conclude the center circle must have a radius of curvature smaller than the Fit on K area. The limitation of a radius of curvature that is smaller than the central zone is met by Fontana 76. Furthermore, Appellant does not dispute this finding.

Fontana 76 is silent as to the lateral thickness of the areas of the lens as well as to any order of grinding the lens.

However, unlike Fontana 74, the lateral thickness of the areas are *inherent* in the Fontana 76. An inherent disclosure, to be invalidating as an "anticipation," is a disclosure that is necessarily contained in the prior art, and would be so recognized by a person of ordinary skill in the art. ***Continental Can Co. USA, Inc. v. Monsanto Co.***, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). "Inherency" charges the inventor with knowledge that would be known to the art, although not described. Inherency is not a matter of hindsight based on the applicant's disclosure: the missing claim elements must necessarily be present in the prior art. ***In re Schreiber***, 128 F.3d 1473, 1481, 44 USPQ 1429, 1435 (Fed. Cir. 1997).

We find that the missing claimed element, the lateral thickness of the zones, is necessarily present in the Fontana 76 disclo-sure. Fontana 76 on page 83, column 1, teaches that the lens should have "a slight apical contact [with the cornea] at the center of the lens and good drainage throughout the remainder of the lens area". Also, Fontana 76 teaches on

page 81 that the curvature of "Fit on 'K'" area is the flattest meridian of the keratometer reading of the patient's cornea, the curvature of the cornea and the "center circle" area is designed to be flatter than the of "Fit on 'K'" area. On page 83, second column,

Fontana 76 teaches that the object of the treatment is to have the patient's cornea reshaped to the flatter curvature of the "center circle" area.

We find that the only way possible to have a lens charact-erized as the aforementioned is to have the center circle with a lateral thickness greater than the "Fit on 'K'" area. The greater thickness of the center circle allows for apical touching, and thereby allows for the reshaping treatment. Indeed, the purpose of the apical touching of the cornea to the center circle, as stated in column 2 of page 83 of Fontana 76, is for the cornea to assume the curvature of the central circle of the lens (which will eventually prompt a refitting). In contrast, a lesser degree of lateral thickness is required in the "Fit on 'K'" area which allows for good drainage. Thus, in order to meet these objectives of good

drainage and the apical contact to cause the reshaping treatment, we find that missing claimed element, the lateral thickness of the zones, is necessarily present in the Fontana 76 disclosure. Therefore, we find that Fontana 76 teaches all of the limitations of Appellant's claim 1 and thereby we will sustain the Examiner's rejection of claims 1 through 10 and 16.

In regard to claim 10 through 15, Appellant does not provide any further argument that has not been addressed above. We are

not required to raise and/or consider such issues. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR § 1.192 c)(8)(iv) (July 1, 1996) ***as amended at*** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellant's filing the brief, states as follows:

> For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that this board is not under any greater burden than the court which is not under any burden to raise and/or consider such issues.

In view of the foregoing, the decision of the Examiner rejecting claim 1 through 10 and 16 under 35 U.S.C. § 102 as being anticipated by Fontana 76 is affirmed. In addition, the decision of the Examiner rejecting claim 11 through 15 under 35 U.S.C. § 103 as being unpatentable over Fontana 76 and Graham is affirmed. However, the decision of the Examiner rejecting said claims as being anticipated by Fontana 74 is

not sustained and thus reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMESON LEE Administrative Patent Judge	)	

David J. Oldenkamp
Poms, Smith, Lande & Rose
2029 Century Park East
Suite 3800
Los Angeles, CA 90067-3029

Roy W. Hardin
Harris, Tucker & Hardin
13355 Noel Road
Suite 2100

Dallas, TX 75240